

Claim 1 recites that modifying the appearance of at least one visible element comprises automatically overlaying an overlay element on or near the reduced size representation in association with the at least one visible element based on importance of the at least one visible element, and that the overlay element comprises one or more of an enlarged version of a visible element, a zoom of the visible element, a callout visibly connected with the visible element, a blurry text version of the visible element and a perspective text version of the visible element. The callout is described in the specification at, for example, paragraphs [0065] and [0079]-[0081] and shown in Fig. 5.

The Office Action admits that Ogden does not teach or suggest these features, but alleges that Manber does. In particular, the Office Action asserts that Manber teaches emphasis on important elements, which allegedly correspond to the recited callout. Applicants respectfully disagree.

As described in the specification at, for example, paragraph [0065], callouts are enlarged text overlays, which are rendered on top of or next to a reduced-size representation, which may be an image of the first page of a document or any specified view within the document, as shown in Fig. 5. That is, as discussed during the interview, callouts, one type of the recited overlay elements, are objects separate from the reduced-size representation provided on or next to the reduced-size representation and corresponding to a version of the visible element. In other words, the overlay elements are not of the reduced-size representation.

Manber, on the other hand, as discussed during the interview, shows in his Fig. 1 merely enlarged and highlighted text phrases of the original document. That is, as described at page 136, lines 1-21, in his way of automatically emphasizing words, Manber teaches the use of an HTTP proxy that is provided between the server and the client browser to filter data.

Then, using the proxy, the words to be emphasized are automatically highlighted and loaded. Manber specifically teaches that the web page is "refreshed" automatically whenever the user changes a file indicating a keyword. Applicants respectfully submit that such teaching implies that the source code of the web page is modified based on the filtered keywords, and that because the tags indicating the emphasis must be used of the keywords, the page needs to be refreshed to take effects of the tags for new keywords. However, at least, Manber does not teach or suggest any specific way of emphasizing the words by overlay. In particular, Applicants respectfully submit that Manber does not teach or suggest specifically the use of a callout.

During the interview, Examiner Stork indicated that the words "health" and "college" as shown in Fig. 1 of Manber could be considered as callouts. However, as discussed during the interview, these words do not appear to be overlaid on the document but appear to be merely enlarged in the document (modified originals), because the words following the emphasized words appear to have shifted by the amount of enlargement of the emphasized words. Thus, these are not overlays separate from the original and associated with the original visible element.

Applicants respectfully submit that an interpretation that construes these enlarged words to correspond to an "overlay" is unreasonable and improper without specific teaching by the prior art. In addition, Applicants respectfully submit that such an interpretation must rely on impermissible hindsight knowledge gained from Applicants disclosure. Thus, Applicants respectfully submit that Patent Office fails to establish a *prima facie* case of obviousness.

Moreover, because Manber only teaches modifying the document to enlarge a part of the document, even combined, Manber's emphasis only effects the original document of

Ogden. Accordingly, Ogden and Manber as combined do not teach or suggest automatically overlaying the overlay element, such as callouts, on or near the reduced size representation in association with at least one visible element, as recited in claim 1. Therefore, claim 1 is patentable over the applied references.

Independent claim 16 recites features similar to those of claim 1. As such, claim 16 is patentable over the applied references.

Claims 2, 3, 6, 7, 9-12 and 17-19 are patentable at least for their respective dependence on claims 1 and 16, as well as for the additional features they recite.

At least for these reasons, Applicants respectfully request withdrawal of the rejection.

The Office Action rejects claim 13 under 35 U.S.C. §103(a) over Ogden and Manber, further in view of "Perceptual Thumbnail" by Chiou et al. (Chiou); and rejects claims 14 and 15 under 35 U.S.C. §103(a) over Ogden, Manber and Chiou, further in view of U.S. Patent No. 6,708,309 to Blumberg. These rejections are respectfully traversed.

Neither Chiou nor Blumberg overcomes the deficiency of Ogden and Manber with respect to claim 1. Therefore, claims 13-15 are patentable at least for their dependence on claim 1, as well as for the additional features they recite. Accordingly, withdrawal of these rejections is respectfully requested.

The Office Action rejects claims 21-30 and 34-42 under 35 U.S.C. §103(a) over Ogden and Manber, further in view of U.S. Patent No. 6,275,829 to Angiulo et al. (Angiulo). The rejection of canceled claims 23, 24, 29, 41 and 42 is moot. The rejection is respectfully traversed with respect to the remaining claims.

It appears that the inclusion of claim 38 in this rejection is an error, as the features of claim 38 are not addressed with respect to this rejection. Further, claim 38 is rejected under separate grounds as discussed below.

Independent claims 21 and 28 each recite that an overlay element comprises one or more of an enlarged version of a visible element, a zoom of the visible element, a callout visibly connected with the visible element, a blurry text version of the visible element and a perspective text version of the visible element. As discussed during the interview and as discussed above with respect to claim 1, Ogden and Manber do not teach or suggest these features. Angiulo does not overcome this deficiency. Thus, Applicants respectfully submit that claims 21 and 28 are patentable over the applied references.

Claims 22, 25-27, 30 and 34-40 are patentable at least for their respective dependence claims 21 and 28, as well as for the additional features they recite.

At least for these reasons, Applicants respectfully request withdrawal of this rejection.

The Office Action rejects claim 31 under 35 U.S.C. §103(a) over Ogden, Manber and Angiulo, and further in view of Chiou; and rejects claims 32 and 33 under 35 U.S.C. §103(a) over Ogden, Manber, Angiulo, Chiou, and further in view of Blumberg. These rejections are respectfully traversed.

Neither Chiou nor Blumberg overcomes the deficiency of Ogden, Manber and Angiulo with respect to claim 21. Therefore, claims 31-33 are patentable at least for their dependence on claim 21, as well as for the additional features they recite. Accordingly, withdrawal of these rejections is respectfully requested.

The Office Action rejects claims 8 and 20 under 35 U.S.C. §103(a) over Ogden and Manber, further in view of U.S. Patent Publication Application No. 2002/0167534 to Burke. This rejection is respectfully traversed.

With respect to claim 8, Burke does not overcome the deficiency of Ogden and Manber with respect to claim 1. Accordingly, claim 8 is patentable at least for its dependence on claim 1, as well as for the additional features it recites.

Independent claim 20 recites modifying an appearance of at least one important element relative to other elements of the plurality of elements in the reduced-size representation by automatically overlaying a semi-transparent modified version of the important element on or near the reduced-size representation that allows an underlying portion of the reduced-size representation to be partially visible.

As discussed during the interview and as discussed above, Manber only teaches emphasizing phrases by merely enlarging and highlighting them. None of the applied references teach or suggest overlaying a modified version of the important element on or near the reduced-size representation and allowing an underlying portion of the reduced-size representation to be partially visible.

In addition, the Response to Arguments section of the Office Action states that the examiner agrees with the Applicant's assertion that the portion not covered by the overlay is the portion to be highlighted. However, the Office Action states that the examiner is relying on the Burke reference strictly to teach a semi-transparent overlay, allowing for text to be viewed through the overlay. Applicants respectfully submit that this assertion is improper.

MPEP §2142 clearly states that the references must be considered as a whole and that the references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention. In addition, MPEP §2143.01 clearly states that the proposed modification cannot change the principle of operation of reference.

As discussed during the interview, when Burke is considered as a whole, it is clear that Burke's semi-transparent overlay is applied to the non-important areas. Therefore, applying the semi-transparent overlay as suggested by the Patent Office is based on the impermissible hindsight knowledge gained from Applicants' disclosure and alter the principle of operation of Burke. Therefore, such modification is improper. Moreover, the alleged

overlay is not a semi-transparent modified version of the important element, but rather is just a shaded or highlighted portion.

At least for these reasons, none of the applied art teaches or suggests this feature. As such, claim 20 is patentable over the applied references.

Accordingly, withdrawal of the rejection is respectfully requested.

The Office Action rejects claims 30 and 38 under 35 U.S.C. §103(a) over Ogden, Manber, and Angiulo, further in view of Burke. This rejection is respectfully traversed.

With respect to claim 30, Burke does not overcome the deficiency of Ogden, Manber and Angiulo with respect to claim 28. Accordingly, claim 30 is patentable at least for its dependence on claim 1, as well as for the additional features it recites.

Claim 38 recites that at least one important element is modified by automatically overlaying a semi-transparent modified version of at least one important element on or near the reduced-size representation that allows an underlying portion of the important element of the reduced-size representation to be partially visible.

As discussed above, the Patent Office's modification using Burke is improper. Therefore, Applicants respectfully submit that this rejection is improper. As such, claim 38 is patentable over these references.

Accordingly, withdrawal of the rejection is respectfully requested.

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of the application are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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Date: February 27, 2006

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